# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/836,386 | 04/18/2001 | Susumu Honma | 109296 | 7176 |

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| EXAMINER |
|---|
| EHICHIOYA, FRED I |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2162 | |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>01 April 2005</u>.

2a)☐ This action is **FINAL.**      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>1 - 16</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 - 16</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1. This action is responsive to communications: RCE filed April 1, 2005 to the original

application filed 04/180/01.

2. Claims 1 – 16 are pending.

### *Continued Examination Under 37 CFR 1.114*

3. A request for continued examination under 37 CFR 1.114, including the fee set forth

in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

04/01/2005 has been entered.

### *Response to Arguments/Remarks*

4. Applicants' argue:

(a) "Shimotsuji and Smith, individually and together, fail to teach or suggest a data

input form retrieving system comprising keyword adding unit that adds a keyword

inputted by a user or automatically generated by natural language analysis to each of

plural data input forms" (page 8, paragraph 1).

(b)     "Nor do Shimotsuji and Smith teach or suggest a data input form retrieving

system, comprising: a character string extracting unit that extracts a character string

from each of plural data input forms containing character strings in accordance with a

predetermined rule for extracting the character string from a specific kind of character

string part" (page 8, paragraph 2).

In response to argument (a), Examiner respectfully disagrees with the applicants.

Shimotsuji discloses, "adds a keyword inputted by a user as shown in column 1, lines

35 - 36 as described in column 7, lines 53 – 64).

In response to argument (b), Pleas see rejection 35 U.S.C. 112, first paragraph for

claims 13 and 15 which fail to comply with the enablement requirement. Therefore,

Examiner gives reasonable interpretation to the phrase "predetermined rule" since this

was not defined by the claim or specification. Hence, Smith discloses a predetermined

rule for extracting the character string from specific king of character string part as

shown in column 6, lines 47 – 51.


## Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 4, 5, 8, 13 and 15 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

A process that merely manipulates an abstract idea or performs a purely

mathematical algorithm is nonstatutory, despite the fact that it might inherently have

some usefulness, Sarkar, 588 F.2d at 1335, 200 USPQ at 139. For such subject matter

to be statutory, the claimed must be limited to a practical application of the abstract idea

or mathematical algorithm in the technological arts, Alappat, 33 F.3d at 1543, 31 USPQ2d at 1556-57.

In practical terms, claims define nonstatutory processes if they simply manipulate abstract ideas, e.g., a bid or a bubble hierarchy, without some claimed practical application, Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59; Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759.

Regarding claims 1, 4, 13 and 15, that recite "a data input form retrieving system" merely manipulate an abstract idea, and hence nonstatutory because it does not represent a practical application of the idea.

Regarding claims 8 and 15, that recite "a data input form retrieving method" merely manipulate an abstract idea, and hence nonstatutory because it does not represent a practical application of the idea.

The dependent claims also inherit these deficiencies and therefore, rejected under 35 U.S.C. 101 since they are also directed to nonstatutory subject matter.

## *Claim Rejections - 35 USC § 112*

7.  The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.  Claims 1, 4, 5, 8, 13 and 15 are also rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. Computer application is critical or essential to the practice of the invention, but not included in the claim(s), therefore, is not enabled by the disclosure.  See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The dependent claims also inherit these deficiencies and therefore, rejected under 35 U.S.C. 112, first paragraph.

9.  Claims 13 and 15 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.  The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 15 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 13 and 15, the term "predetermined rule" in claims 13 and 15 is relative which renders the claim indefinite. The term "predetermined rule" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

## *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1 - 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent 5,815,704 issued to Shigeyoshi Shimotsuji et al (hereafter

"Shimotsuji") in U. S. Patent 6,381,592 issued to Stephen Michael Reuning

(hereinafter "Reuning").


Regarding claim 1, Shimotsuji discloses A data input form retrieving system,

comprising:

a character string extracting unit that extracts a character string from each

of plural data input forms containing character strings (see column 1, lines 55 – 57 and

column 4, lines 2 – 6).

an extracting conditions input unit that inputs a condition of extracting a

specific data input form from the plural data input forms (see column 2, lines 15 – 17);

a data input form extracting unit that extracts the specific data input form

(see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach text file as claimed.

However, Reuning teaches text file containing the extracted character

strings in association with a corresponding data input form (see column 5, lines 43 – 49

and column 7, lines 10 – 17); and

retrieving the character string contained in the text file in accordance with

the extracting condition inputted by the extracting condition input unit (see column 7,

lines 10 – 17).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Reuning's teaching of "text file containing the extracted character strings in association with a corresponding data input form" would have allowed Shimosuji's system a distinctive and non-obvious method for delivering identical electronic mail messages to a group of targeted potential job candidates sharing a specifically desired single or set of common experiences, interests, capabilities, professional titles or talents relating to the needs of the candidate seeking hiring entity and handling their response as suggested by Reuning (see Abstract).

Regarding claims 2, 6 and 10, Reuning teaches wherein all the character strings contained in each of the plural data input forms are extracted (see column 3, lines 12 – 13 and column 7, lines 11 – 12).

Regarding claims 3, 7 and 11, Reuning teaches wherein a specific character string is selected out of the character strings contained in the plural data input forms (see column 7, lines 26 – 31).

Regarding claims 4, 8 and 12, Shimotsuji teaches a data input form retrieving system, comprising:

a keyword adding unit that adds a keyword inputted by a user or automatically generated by natural language analysis to each of plural data input forms (see column 1, lines 35 – 36);

an extracting condition input unit that inputs a condition of extracting a specific data input form from the plural data input forms see column 2, lines 15 – 17);

and a data input form extracting unit that extracts the specific data input form by retrieving the keyword added by the keyword adding unit in accordance with the extracting condition inputted by the extracting condition input unit (see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach a text file as claimed.

Reuning teaches a text file containing the keywords extracted from the data input form is made up when the keywords have been extracted from each of the plural data input forms (see column 6, lines 16 – 26).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Reuning's teaching of "text file containing the extracted character strings in association with a corresponding data input form" would have allowed Shimosuji's system a distinctive and non-obvious method for delivering identical electronic mail messages to a group of targeted potential job candidates sharing a specifically desired single or set of common experiences, interests, capabilities, professional titles or talents

relating to the needs of the candidate seeking hiring entity and handling their response

as suggested by Reuning (see Abstract).

Regarding claims 5 and 9, Shimotsuji teaches a data input form retrieving

method,

comprising:

extracting a character string from each of plural data input forms

containing character strings (see column 3, lines 46 – 47 and column 4, lines 2 – 6);

inputting a condition of extracting a specific data input form from the

plural data input forms (see column 6, lines 8 – 20).

Shimotsuji does not explicitly teach text file as claimed.

However, Reuning teaches making up a text file containing the extracted

character strings in association with a corresponding data input form (see column 5,

lines 43 – 49); and

extracting the specific data input form by retrieving the extracted character

string contained in the text file in accordance with the inputted extracting condition (see

column 7, lines 10 – 17).

It would have been obvious to one of ordinary skill in the data processing

art at the time of the present invention to combine teaching of the cited references

because Reuning's teaching of "text file containing the extracted character strings in

association with a corresponding data input form" would have allowed Shimosuji's

system a distinctive and non-obvious method for delivering identical electronic mail

messages to a group of targeted potential job candidates sharing a specifically desired

single or set of common experiences, interests, capabilities, professional titles or talents

relating to the needs of the candidate seeking hiring entity and handling their response

as suggested by Reuning (see Abstract).

Regarding claims 14 and 16, Shimotsuji teaches wherein the character string

part is a noun part or a non-sentence part (see column 1, lines 55 – 66).

13. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shimotsuji in view of Smith.

Regarding claim 13, Shimotsuji teaches a data input form retrieving system,

comprising:

a character string extracting unit that extracts a character string from each of

plural data input forms containing character strings (see column 1, lines 55 – 57 and

column 4, lines 2 – 6).

an extracting condition, input unit that inputs a condition of extracting a

specific data input from the plural data input forms (see column 2, lines 15 – 17); and

a data input form extracting unit that extracts the specific data input form by

retrieving the character string extracted by the character string extracting unit in

accordance with the extracting condition inputted lay the extracting condition input unit

(see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach predetermined rule.

Smith teaches a predetermined rule for extracting the character string from a specific kind of character string part (see column 6, lines 47 – 51).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Smith's teaching of "a predetermined rule for extracting the character string from a specific kind of character string part" would have allowed Shimosuji's system to provide data capture with storage to a local file through a WEB Browser for retaining a personal record of a business transaction and for later transmission through the Internet in a connect mode to a WEB server computer as suggested by Smith (see Abstract).

Regarding claim 15, Shimotsuji teaches a data input form retrieving method, comprising:

extracting a character string from each of plural data input forms containing character strings (see column 1, lines 55 – 57 and column 4, lines 2 – 6); and

extracting the specific data input form by retrieving the extracted character string in accordance with the inputted extracting condition (see column 2, lines 15 – 17).

Shimotsuji does not explicitly teach predetermine rule.

However, Smith teaches a predetermined rule for extracting the character string from a specific kind of character string part (see column 6, lines 47 – 51); and

inputting a condition of extracting a specific data input form from the plural data input forms (see column 9, lines 4- 52).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Smith's teaching of "a predetermined rule for extracting the character string from a specific kind of character string part" would have allowed Shimosuji's system to provide data capture with storage to a local file through a WEB Browser for retaining a personal record of a business transaction and for later transmission through the Internet in a connect mode to a WEB server computer as suggested by Smith (see Abstract).

## *Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

June 11, 2005

SHAHID ALAM
PRIMARY EXAMINER